

In re: Denecke et al.
Serial No.: 09/868,434
Filed: June 15, 2001
Page 2 of 3

common special technical feature. It is further stated that the technical feature linking the groups is a method comprising causing a plant to maintain a level of BiP greater than the endogenous level. The Examiner argues that this technical feature is taught by Crofts et al., (1998) *Plant Cell* 10:813-23.

The Applicants respectfully elect the claims of Group I (Claims 1-5, 7, 10-11 and 14-16) with traverse. The basis for the traversal is discussed below.

The Applicants respectfully disagree with the present restriction requirement and request reconsideration thereof. In particular, it is respectfully submitted that the Examiner has failed to appreciate the inventive concept of the invention as reasoned below.

The Office Action states that there is not a single general inventive concept because the claim groups lack a common special technical feature. The Examiner has stated that the technical feature linking the groups is a method comprising causing a plant to maintain a level of BiP greater than the endogenous level and, further, that this technical feature is taught by Crofts et al. Applicants respectfully disagree with the Examiner's assessment of the inventive concept. The inventive concept does not reside in a method of increasing BiP levels, but rather in the consequence of elevated BiP levels, *i.e.*, it had not hitherto been recognized that elevated BiP levels confer greater pathogen resistance to plants.

The technical detail taught by the Crofts et al. reference was provided in the specification merely as an example to illustrate representative means by which high levels of BiP could be achieved without direct over-expression. The examples given were not envisaged as exhaustive, as is stated on page 5, lines 19-21, of the specification.

Knowledge of the crucial role of BiP could be used in numerous ways to circumvent direct over-expression of BiP, while still achieving pathogen resistance. The claims of the present application are directed to elevating BiP, homologues or other molecules having equivalent activity be they yeast derived or plant derived, or even completely artificial but containing BiP activity, so as to confer pathogen resistance to the plant. This concept is stated on page 5, lines 2-3, of the

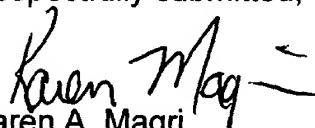
In re: Denecke et al.
Serial No.: 09/868,434
Filed: June 15, 2001
Page 3 of 3

application, which recites: "The method of the present invention thus harnesses the plants own defence mechanism" and in the preamble of the Field of the Invention (page 1, lines 6-8), which states that "the invention relates to methods of increasing the resistance of plants to pathogen attack. The invention also provides plants modified to improve their pathogen resistance without loss of productivity/yield."

The three groups of claims identified in the Restriction Requirement are linked by the single inventive concept of achieving greater pathogen resistance as a consequence of elevating BiP levels or homologues thereof or other molecules having equivalent activity. The Applicants therefore respectfully request reconsideration of the Restriction Requirement and examination of all of the claims as they share a common technical feature, *i.e.*, increased pathogen resistance.

The Applicants further request reconsideration of the restriction on the basis that it would not be an undue burden to search and examine all of the claims concurrently as all of the claims share a common technical feature.

Respectfully submitted,


Karen A. Magri
Registration No. 41,965

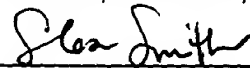
Customer Number:



20792

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 17, 2003


Sloan Smith